

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to the drawings because reference numeral 144 on the bottom left of Figure 42 is pointing to tape 143. In response, Figure 42 has been amended to change reference numeral 144 to reference numeral --143--. A Replacement Sheet for Figure 42 showing the amendment is enclosed. Accordingly, it is respectfully requested that the objection to the drawings be withdrawn.

In the Official Action, the Examiner rejects claims 17 and 24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,470,338 to Whitfield et al., (hereinafter "Whitfield"). Furthermore, the Examiner rejects claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Whitfield in view of U.S. Patent No. 3,839,772 to Shimomura et al., (hereinafter "Shimomura"). Lastly, the Examiner rejects claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Whitfield and Shimomura further in view of U.S. Patent No. 6,013,095 to Ouchi (hereinafter "Ouchi").

In response, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102(b) and 103(a) for at least the reasons set forth below. However, independent claim 17 has been amended to clarify its distinguishing features. Specifically, independent claim 1 has been amended to clarify that the groove having an annular form, and being engageable with the at least one arm at a plurality of points, wherein when the groove and the at least one arm are located in the guide, the recovery member and the elongated circular member keeps an engagement with each other. The amendment to claim 17 is fully supported in the original disclosure, such as at Figures 182A-182C and 183 of the Drawings

and the accompanying text of the Specification. Thus, no new matter has been introduced in the disclosure by way of the amendment to claim 17.

Whitfield discloses an exclusive tool to close an opening formed by a trocar. The tool of Whitfield is not used with an endoscope, and the depth that a needle is pierced is shallow. The object to be treated, the structure, and the method for using the tool of Whitfield are different from the treatment device as recited in claim 17. In particular, none of the cited references, including Whitfield, discloses or suggests that the recovery member recited in claim 17 has an outer periphery portion with an annular groove, and an inner hole, and when the groove and the arm are located in the guide, the recovery member and the elongated circular member keeps an engagement with each other.

Although Shimomura discloses an elastic member (11), the device of Shimomura relates to a blade of a cutting tool having an objective that is clearly different from that of the medical treatment device of claim 17.

With regard to the rejection of claims 17 and 24 under 35 U.S.C. § 102(b), a treatment device having the features discussed above and as recited in independent claim 17, is nowhere disclosed in Whitfield. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claim 17 is not anticipated by Whitfield. Accordingly, independent claim 17 patentably distinguishes over Whitfield and is allowable. Claim 24 being dependent upon claim 17 is thus at least allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 17 and 24 under 35 U.S.C. § 102(b).

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

With regard to the rejection of claims 22 and 23 under 35 U.S.C. § 103(a), since independent claim 17 patentably distinguishes over the prior art and is allowable, claims 22 and 23 are at least allowable therewith because they depend from an allowable base claim. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 22 and 23 under 35 U.S.C. § 103(a).

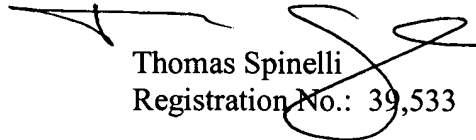
Furthermore, new claim 25 has been added to further define the patentable invention. New claim 25 is fully supported in the original disclosure such as at Figure 191 of the Drawings and the accompanying text of the specification. Thus, no new matter has been entered into the disclosure by way of the addition of new claim 25. Applicants respectfully submit that new claim 25 is at least allowable as depending upon an allowable base claim (17).

In the Official Action, the Examiner provisionally rejects claim 17 under 35 U.S.C. § 101 as claiming the same invention as that of claim 17 in copending Application No. 10/958,801. In response, Applicants request that the Examiner reconsider such rejection in light of amended claim 17. However, if the Examiner maintains such rejection in light of the present amendment to claim 17, Applicants submit that claim 17 in copending Application No. 10/958,801 will be canceled upon the indication of allowability in the present application.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case,
the Examiner is requested to telephone the undersigned.

Respectfully submitted,


Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser PC
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

TS:cm

Encl. (Replacement Sheet for Amended Figure 42)